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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/727,633   | 12/01/2000  | Katsumi Yoshizawa    | 450100-02891        | 4183             |
| 20999  | 7590        | 11/18/2004           | EXAMINER            |                  |
| FROMMERM LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | DURAN, ARTHUR D     |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 3622                 |                     |                  |

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                 |              |              |                    |
|-----------------|--------------|--------------|--------------------|
| Application No. | 09/727,633   | Applicant(s) | YOSHIZAWA, KATSUMI |
| Examiner        | Arthur Duran | Art Unit     | 3622               |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 10/14/04.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 9,10,12-14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9,10,12-14,16 and 17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

1. Claims 9, 10, 12-14, 16, 17 have been examined.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/04 has been entered.

### ***Response to Amendment***

3. The Amendment filed on 10/14/04 is insufficient to overcome the Kanter, Postrel, and Hoffman reference.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9, 10, 12-14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Postrel (6,594,640) in further view of Hoffman (6,012,039).

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Claim 9, 10, 12-14, 16, 17: Kanter discloses an information processing apparatus, method for processing information concerning electronic commerce in which a customer receiving services offered by a service provider obtains points in accordance with the amount of money having been paid to said service provider, said information processing apparatus comprising:

first communication controlling means for controlling data communication with another information processing apparatus via a first network (Fig. 1);

first recording means for recording information on a plurality of the service providers and information on a plurality of the customers receiving services from said plurality of service providers (Fig. 1);

second communication controlling means for controlling data communication with a financial institution information processing apparatus via a second network (Fig. 1);

payment computing means for computing an amount of money to be refunded to said customer in accordance with the number of the points said customer owns (col 4, lines 59-67; col 7, lines 5-7); and

signal generating means for generating a signal that requests said financial institution information processing apparatus having an account of said customer to transfer a predetermined amount of money to the account of said customer (col 4, lines 59-67; col 7, lines 5-7), wherein:

said first communication controlling means controls communication in which a signal corresponding to the amount of money computed by said payment computing means is sent to an information processing apparatus owned by said customer and a signal corresponding to a desired amount of transfer money is received from the information processing apparatus owned by said customer (col 4, lines 59-67; col 7, lines 5-7); and

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said second communication controlling means controls communication in which the signal generated by said signal generating means is sent to said financial institution information processing apparatus and a signal representing completion of processing by said financial institution information processing apparatus is received (col 4, lines 59-67; col 7, lines 5-7; col 22, lines 20-50; col 22, line 60-col 23, line 2; col 23, lines 25-45; col 27, lines 40-50).

Kanter further discloses key generating means for generating an encryption key for encrypting and decoding communication data (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65-col 19, line 2; col 23, lines 45-55).

Kanter further discloses authenticating means for authenticating said other information processing apparatus with which communication is controlled by said first communication controlling means (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65-col 19, line 2; col 23, lines 45-55).

Kanter further discloses receiving means for receiving a point redemption request for redeeming points owned by said customer for money, said point redemption request including information on the number of points which is desired to be redeemed for money from among the total points owned by said customer (col 4, lines 59-67; col 7, lines 5-7);

transferring means for transferring, to an account of said customer, an amount of money corresponding to the desired number of points in the information included in said point redemption request from among the total points (col 4, lines 59-67);

and updating means for updating the total points corresponding to said customer (col 24, lines 6-18).

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Kanter does not explicitly disclose updating means for updating the total points corresponding to said customer by subtracting the desired number of points in the information included in said point redemption request from the total points owned by said customer.

Since Kanter discloses the customer having a total points and the customer redeeming the points for cash, it is obvious that Kanter would balance the account of the customer after a points redemption.

Kanter does not explicitly disclose e-commerce over an open network.

However, Postrel discloses e-commerce over an open network (Fig. 4; Fig. 5; col 5, lines 31-36; col 1, lines 13-17; col 1, lines 50-53).

Postrel further discloses a point issuing system and point redemption system which are separate from the plurality of service providers (Fig. 5).

Postrel further discloses that all points control, transfer, redemption, tracking services, can be performed by a server or service separate from the user or merchant (Fig. 4; Fig. 5).

Postrel further discloses authenticating the customer (col 11, line 61-col 12, line 1; col 6, lines 3-7).

Postrel further disclose updating means for updating the total points corresponding to said customer by subtracting the desired number of points in the information included in said point redemption request from the total points owned by said customer (col 5, lines 50-60; col 1, lines 13-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Postrel's utilization of merchant's accessible over the Internet to

Kanter's utilization of multiple merchants. One would have been motivated to do this in order to allow Kanter's users to access a wider range of merchants.

Additionally, Kanter further discloses wherein said authenticating means authenticates said other information processing apparatus based on a unique identifier thereof which is received under the control of said first communication controlling means and which is issued from an authority connected to said first network (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65-col 19, line 2; col 23, lines 45-55).

Kanter does not explicitly disclose that said authenticating means authenticates based on a certificate issued from a predetermined certificate authority connected to said first network.

However, Hoffman discloses authenticating means authenticates based on a certificate issued from a predetermined certificate authority connected to said first network (col 10, lines 43-55; col 13, lines 10-20; col 14, lines 60-70; col 7, lines 65-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hoffman's utilization of digital certificates over to Kanter's authenticated transmissions. One would have been motivated to do this because digital certificates are one standard for authenticated transmissions that is popular in the industry.

Additionally, Kanter further discloses that a user is uniquely identified (col 4, lines 39-67; col 18, line 62-col 19, line 5) and then issued a unique certificate (col 4, lines 39-67).

Kanter further discloses uniquely identifying the points that are appropriate to different accounts (col 21, line 55-col 22, line 6); transferring unique amounts of points after a user has been identified (col 22, lines 25-32); that specific amounts of credit or points are transferred to

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the users account and that the unique cash must be transferred to the appropriate institution (col 22, lines 34-41).

Kanter further discloses unique wire transfers (col 22, line 60-col 23, line 2); issuing unique point transfers only under specific conditions (col 24, lines 32-40); issuing unique, identifiable points transfers to users (col 27, lines 40-50); and uniquely identified awards and points transfers (col 28, lines 35-45).

Kanter further discloses utilizing identifiers (col 31, lines 31-42).

Kanter also discloses joint or common accounts that can be utilized for all aspects of the invention (col 27, lines 60-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Kanter's providing unique point transfer amounts with unique qualities to a user who has been identified can include identifiers related to the user for the point transfer. One would have been motivated to do this in order to better track the utilization of points.

Additionally, Kanter discloses that joint or common accounts can be utilized for all aspects of the disclosure. Therefore, it would be obvious that after a user has been identified, the user can be given access to a common account from which points redemption will occur. One would be motivated to do this in order provide redemption for users utilizing group accounts.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 9, 10, 12-14, 16, 17 have been considered but are not found persuasive.

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Note that the grounds of rejection utilized for former dependent claims 11, 15 was applied to all the features of those dependent claims as well as the claims upon which claims 11, 14 depended. Therefore, the current grounds of rejection is not new.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. For example, the feature of "A common point issuing step of issuing a common point ID for authenticating the customer based on the user certificates issued in the authentication step" can be interpreted in several ways. For example, the claim can be interpreted as stating that after the user has been identified, issuing a unique ID related to a point transfer or as issuing a common account ID to a user that multiple users can utilize.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran  
Patent Examiner  
11/4/04